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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,331	08/23/2004	Christoph Euscher	112740-995	3784
29177	7590	07/17/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			SING, SIMON P	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/505,331

Applicant(s)

EUSCHER ET. AL.

Examiner

Simon Sing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-24 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 and 26-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 20, 21, 24 26 and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kung et al. US 6,671,262.

1.1 Regarding claim 20, Kung discloses a method of video conferencing, comprising steps of:

establishing a multi-party connection between a first subscriber and a plurality of subscribers (column 30, lines 13-29);

establishing a plurality of information types that identify the first subscriber assigned to a communication terminal (column 33, lines 52-67);

selecting and transmitting different information types to the plurality of subscribers (column 33, lines 52-67); and

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providing that the information of at least one information type (audio or image) other than text (at least one information excluding a text information).

1.2 Regarding claim 21, Kung teaches that the information is stored in a telecommunication network (column 33, lines 52-67).

1.3 Regarding claim 24, Kung teaches that at least one information type is image (visual information) (column 33, lines 61-67).

1.4 Regarding claim 26, Kung teaches announcing the name of first subscriber (column 33, lines 52-55).

1.5 Regarding claim 29, Kung teaches displaying an image (column 33, lines 61-67).

1.6 Regarding claim 30, Kung teaches announcing (audio type) the first subscriber and also displaying text and image associated with the first subscriber (column 33, lines 52-67).

1.7 Regarding claim 31, Kung teaches displaying text and image (column 33, lines 61-67).

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1.8 Regarding claim 32, it is inherent that a reception terminal can mute its audio output.

2. Claims 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Paik et al. US 6,675,008.

2.1 Regarding claim 34, Paik discloses a terminating terminal 10b in figures 1, 2 and 5, for identifying an originating party via information received (column 4, lines 31-50; column 5, lines 41-62; column 9, lines 26-33, 62-67; column 10, lines 1-8) comprising:

a picture display unit 11 for displaying a caller picture information (column 11, lines 12-22, 52-58); and

a speaker 13 for outputting a caller audio information (column 11, lines 12-22);

2.2 Regarding claim 35, Paik teaches a memory 9 for storing caller picture information (column 11, lines 52-58).

2.3 Regarding claim 36, Paik also teaches a LCD display unit 12 for display caller character information (column 11, lines 12-22) and the character information is combined with picture information (column 5, lines 10-13; column 9, lines 26-33).

2.4 Regarding claim 37, it is inherent that when the terminating terminal is in a silent (vibrating) mode, selected by its user, audio information is inhibited (restricted).

3. Claims 34, 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Kraft et al. US 2003/0083050.

3.1 Regarding claim 34, Kraft teaches a receiving terminal comprising means for outputting at least one personal item from a transmitting terminal (figures 1 and 2; para. 0024-0028, 0075-0077).

3.2 Regarding claim 35, Kraft teaches a memory for storing the personal item (para. 0079).

3.3 Regarding claim 37, Kraft teaches restricting a personal item at the receiving terminal (para. 0075).

4. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Frank et al. WO 99/25107.

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Frank teaches sending information from a calling terminal to a called terminal for identifying a caller, the information including personal image or a ring tone (excluding text information), selected by the caller (page 2, lines 11-17; page 5, lines 6-25; page 6, lines 4-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20, 22, 23, 27, 28, 36, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. US 2003/0083050 in view of Penfield et al. US 6,480,591.

5.1 Regarding claims 20 and 38, Kraft teaches a method for sending personal items from a calling terminal to a called terminal, comprising steps of:

establishing a plurality of information types, such as image and audio (ring tone) that identify a caller (first terminal) (paragraphs 0002, 0033, 0035, 0064 and 0072);

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providing that the information of at least information type exclude information of text information type to a called party (para. 0062-0064, 0066, 0072, and 0078);

Kraft teaches that the personal items are transmitted to a called party with a call-setup or during a call (para. 0071), but fails to teach a conference call.

However, Penfield teaches a method for establishing a conference call in mobile communication systems. Penfield teaches establishing a first connection with a second subscriber, put the second subscriber on hold, and then stabling another connection with a third subscriber (column 6, lines 15-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Kraft's reference with the teaching of Penfield, so that Kraft's mobile terminals would have been able to make conference calls in addition of sending and receiving non-text caller IDs, because such a modification would have enabled a user to make conference calls.

5.2 Regarding claim 22, Kraft teaches storing the received personal item of a calling terminal (para. 0079).

5.3 Regarding claims 23 and 39, Kraft teaches storing the information in a calling terminal (para. 0066, 0072).

5.4 Regarding claims 27 and 28, Kraft teaches using a ring-tone to identify a calling party (abstract; para. 0064).

5.5 Regarding claim 36, Kraft teaches selecting a personal item to transmit (para 0062-0064).

5.7 Regarding claim 41, Kraft teaches storing personal items, including image and audio (ring tones) are stored in a memory, which also stores a phone directory (para. 0028, 0029, 0062-0066).

6. Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosecrans et al US 5,889,852 in view of Penfield et al. US 6,480,591.

6.1 Regarding claim 38, Rosecrans teaches sending a graphical (visual information excluding text information) identifier of a sending party to a receiving phone or a plurality of receiving phones (conference call) when sending and receiving phones are connected (column 3, line 56 to column 4, line 1).

Rosecrans fails to explicitly teach using parts of a sending phone to make a multi-party connection.

However, Penfield teaches a method for establishing a conference call in mobile communication systems. Penfield teaches establishing a first connection with a second subscriber, put the second subscriber on hold, and then stabling another connection with a third subscriber (column 6, lines 15-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rosecrans' reference with the teaching of Penfield, so that the multi-party connection would have been made by dialing different called parties in a conference call, because such a modification would have clarified how the multi-party connection was made.

6.2 Regarding claim 39, Rosecrans teaches storing the graphical identifier in the sending and the receiving phones (column 3, line 56 to column 4, lines 5).

6.3 Regarding claim 40, Rosecrans teaches sending text information together with the graphical information (column 3, line 59 to column 5, line 1).

6.4 Regarding claim 41, Rosecrans teaches storing multimedia information in memory 19 of cellular phone 10 (figure 1; column 3, lines 59-67).

Response to Arguments

7. Applicant's arguments with respect to claims 20-24, 26-33 and 38-41 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 05/03/2006 have been fully considered but they are not persuasive.

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Claims 34-37 are original claims, which do not include the conference call limitation recited in other amended claims (e.g. claims 1 and 38). Since the argument regarding the limitation of conference call does not apply to claims 37-37, and as stated in the previous rejection, the prior arts teach sending a graphical or audio information type (at least one information type excluding text information) to a called party to identify a calling party, then the previous rejection to claims 34-37 was proper.

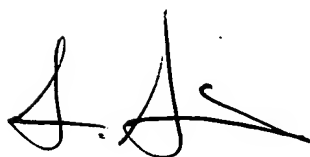
Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

07/10/2006



FAN TSANG
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